

S/N 10/671,913

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Matthew S. Solar et al.	Examiner: Melanie Tyson
Serial No.:	10/671,913	Group Art Unit: 3731
Filed:	September 25, 2003	Docket: 723.061US1
Title:	BALL AND SOCKET TRAJECTORY GUIDE	

PETITION FROM RESTRICTION REQUIREMENT

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The pending claims are as follows:

1. (Previously Presented) An alignment device, comprising:
a longitudinal guide portion, having a longitudinal opening including a guide axis;
a spherical portion coupled to an end of the longitudinal guide portion;
a base unit, having a deformable spherical socket for mating with the spherical portion;
and
an actuating device operatively connected to the spherical socket, wherein the actuating device is not in direct contact with the spherical portion; and
a number of standoff features attached to the base unit, wherein the standoff features are adapted to mount directly to a skull of a subject, and wherein the spherical socket is adapted to mount above a work surface to provide access beneath the spherical socket.
2. (Original) The alignment device of claim 1, further including at least one relief opening in a portion of the spherical socket, allowing deformation of the spherical socket.
3. (Original) The alignment device of claim 1, wherein the actuating device is adapted to cause substantially symmetric tightening of the spherical socket around at least a part of the spherical portion.
4. (Cancelled)

5. (Original) The alignment device of claim 1, wherein the actuating device includes a threaded locking ring adapted to engage a number of threads coupled to the spherical socket.
6. (Original) The alignment device of claim 1, wherein at least one relief opening includes three relief openings substantially equally spaced about a circumference of the spherical socket.
7. (Cancelled)
8. (Withdrawn) The alignment device of claim 1, wherein at least one standoff feature is adapted to contact the work surface along a line.
9. (Previously Presented) The alignment device of claim 1, wherein at least one standoff feature is adapted to contact the work surface along a circle.
10. (Withdrawn) The alignment device of claim 1, further including an orienting fixture attached to the longitudinal guide portion, wherein the orienting fixture is detectable using tissue imaging techniques.
11. (Original) An alignment device, comprising:
 - a longitudinal guide portion, having a longitudinal opening including a guide axis;
 - a spherical portion coupled to an end of the longitudinal guide portion;
 - a base unit, having a spherical socket for mating with the spherical portion;
 - at least one securing device adapted to secure the base unit to a working surface;
 - at least one relief opening in a portion of the spherical socket, allowing deformation of the spherical socket;
 - an actuating device coupled to the spherical socket, adapted to cause substantially symmetric tightening of the spherical socket around at least a part of the spherical portion; and
 - a number of standoff features attached to the base unit, wherein a substantial portion of the base unit is adapted to mount above the work surface.

12. (Original) The alignment device of claim 11, wherein the number of standoff features attached to the base unit includes three standoff features.
13. (Withdrawn) The alignment device of claim 11, wherein the number of standoff features attached to the base unit includes a wedge shaped standoff feature.
14. (Original) The alignment device of claim 11, wherein the number of standoff features attached to the base unit includes a truncated cone shaped standoff feature.
15. (Original) The alignment device of claim 11, wherein the actuating device includes a threaded locking ring adapted to engage a number of threads coupled to the spherical socket.
16. (Original) The alignment device of claim 11, wherein at least one relief opening includes three relief openings substantially equally spaced about a circumference of the spherical socket.
17. (Original) An alignment device, comprising:
 - a longitudinal guide portion, having a longitudinal opening including a guide axis;
 - a spherical portion coupled to an end of the longitudinal guide portion;
 - a base unit, having a deformable spherical socket for mating with the spherical portion;and
 - an actuating device operatively connected to the spherical socket, wherein the actuating device is not in direct contact with the spherical portion;
 - a number of standoff features attached to the base unit, wherein a substantial portion of the base unit is adapted to mount above the work surface; and
 - a screw retention feature coupled to the base unit.
18. (Original) The alignment device of claim 17, wherein the screw retention feature includes an elastomer band.

19. (Original) The alignment device of claim 17, wherein the screw retention feature includes a structure that protrudes into a portion of a screw opening in the base unit.
20. (Original) The alignment device of claim 17, wherein the screw retention feature is located external to, and above a screw opening.
21. (Original) The alignment device of claim 17, wherein at least one standoff feature includes a shelf to determine an attachment thickness.
22. (Original) An alignment device, comprising:
a longitudinal guide portion, having a longitudinal opening including a guide axis;
an insert located substantially within the longitudinal opening wherein an outer diameter of the insert fits closely with the longitudinal opening, and an inner diameter is sized to fit closely with a device to be guided;
a spherical portion coupled to an end of the longitudinal guide portion;
a base unit, having a spherical socket for mating with the spherical portion;
at least one securing device adapted to secure the base unit to a working surface;
at least one relief opening in a portion of the spherical socket, allowing deformation of the socket;
an actuating device coupled to the spherical socket, adapted to cause substantially symmetric tightening of the spherical socket around at least a part of the spherical portion; and
a number of standoff features attached to the base unit, wherein a substantial portion of the base unit is adapted to mount above the work surface.
23. (Original) The alignment device of claim 22, wherein the insert includes an inner diameter that is sized to fit closely with a biopsy probe.
24. (Withdrawn) The alignment device of claim 22, wherein at least one standoff feature is adapted to contact the work surface along a line.

25. (Original) The alignment device of claim 22, wherein at least one standoff feature is adapted to contact the work surface along a circle.
26. (Withdrawn) A method of manufacturing an alignment device, comprising:
forming a longitudinal guide portion with a longitudinal opening that defines a guide axis;
attaching a spherical portion to an end of the longitudinal guide portion;
forming a base unit that includes a spherical socket for mating with the spherical portion;
opening a relief feature in a portion of the spherical socket, allowing deformation of the socket; and
coupling an actuating device to the spherical socket, the actuating device being adapted to cause substantially symmetric tightening of the spherical socket around at least a part of the spherical portion; and
attaching at least one standoff feature to the base unit, wherein a substantial portion of the base unit is adapted to mount above a work surface.
27. (Withdrawn) The method of claim 26, wherein coupling the actuating device to the spherical socket includes coupling a threaded locking ring to the spherical socket to engage a number of threads on the spherical socket.
28. (Withdrawn) The method of claim 26, wherein opening a relief feature in a portion of the spherical socket includes opening three relief openings substantially equally spaced about a circumference of the spherical socket.
29. (Cancelled)
30. (Withdrawn) The method of claim 26, wherein attaching at least one standoff feature to the base unit includes attaching at least one standoff feature to the base unit that is adapted to contact the work surface along a line.

31. (Withdrawn) The method of claim 26, wherein attaching at least one standoff feature to the base unit includes attaching at least one standoff feature to the base unit that is adapted to contact the work surface along a circle.

32. (Withdrawn) The method of claim 26, further including attaching an orienting fixture to the longitudinal guide portion, wherein the orienting fixture is detectable using tissue imaging techniques.

33. (Withdrawn) The method of claim 26, further including placing an insert substantially within the longitudinal opening wherein an outer diameter of the insert is adapted to fit closely with the longitudinal opening, and an inner diameter is sized to fit closely with a device to be guided.

34. (Withdrawn) The method of claim 33, wherein placing an insert substantially within the longitudinal opening includes placing an insert substantially within the longitudinal opening wherein the inner diameter is sized to fit closely with a biopsy probe.

REMARKS

A Restriction Requirement regarding the pending claims (1-3, 5, 6, 8-28 and 30-34) was mailed on August 8, 2006. The claims were restricted to:

- I. Claims 1-25, drawn to an alignment device.
- II. Claims 26-34, drawn to a method of manufacturing an alignment device.

Applicant elected Group I, with traverse, presented appropriate reasons, and requested reconsideration in a Response mailed on September 5, 2006. The Restriction Requirement was made final in an Office Action mailed on October 2, 2006. Applicant maintains that the Restriction is not proper under MPEP §806.05(f). Accordingly, the following Petition from Requirement for Restriction under 37 C.F.R. § 1.144 is presented.

In restricting between the device claims of Group I and the method of manufacture claims of Group II, the Restriction Requirement stated that “in the instant case, the product as claimed can be made by a materially different process, such as blow molding or extrusion.” In response to Applicant’s traversal, the Examiner further stated that “the plain meaning of the term ‘forming’ as used in some of the pending claims does not encompass the manufacturing method blow molding or extrusion for example.”

As explained in Applicant’s previous traversal of the Restriction Requirement, Applicant submits that the Examiner has erroneously misinterpreted the term “forming” as used in some of the pending claims. Without defining the term “forming” for the present purposes of determining whether the Restriction Requirement is proper, Applicant respectfully notes that during examination of a patent application, claims are to be given their broadest reasonable interpretation, consistent with the specification, pursuant to MPEP § 2111. There is no objective evidence anywhere in the present specification that the term “forming” was intended to exclude “blow molding” or “extrusion” or any other particular process of “forming.” Therefore, Applicant respectfully submits that the Examiner has arbitrarily adopted an unduly narrow definition of the term “forming” without providing any objective evidence of any basis for doing so.

The Restriction Requirement further asserted that Groups I-V represent patentably distinct species.

- I. Species I depicted in Figures 1A-1C, base unit having an insert material.
- II. Species II depicted in Figure 2, base unit having a standoff feature with a linear contact surface.
- III. Species III depicted in Figures 3A-3C, base unit having a standoff feature with a circular contact surface.
- IV. Species IV depicted in Figure 4, having an orienting fixture attached to the longitudinal guide portion.
- V. Species V depicted in Figure 5, having extending members attached to the longitudinal guide portion.

Applicant elected, with traverse, species III and claims 1-3, 5, 6, 9-12, 14-23 and 25. Among other things, Applicant traversed the statement that “currently no claim is generic” and explained that at least claim 1 is generic. However, the Examiner responded that claim 1 was not generic “because Figures 1A-C clearly show the base unit lacks the standoff features recited in claim 1.” However, Applicant respectfully submits that the claims themselves—not the figures—determine whether or not a claim is generic, and the Examiner has not provided any objective explanation for why the language of claim 1 is not generic.

Further, the MPEP requires that “Examiners must provide reasons and/or examples to support conclusions.” *See* MPEP § 803. In the present case, however, the Restriction Requirement fails to give any reasons or examples of what renders the asserted Groups I-V patentably distinct. Applicant respectfully submits that this amounts to arbitrary restriction by fiat, rather than providing any reasons as expressly required by the MPEP.

The MPEP also requires that, for purposes of the initial requirement, a serious burden on the Examiner may be *prima facie* shown “by appropriate explanation of separate classification, or separate status in the art, or a different field of search.” *See id.* Because the Restriction Requirement fails to even establish the basic characteristics upon which the restriction rests, it

also necessarily fails to provide any requisite explanation of separate classification, separate status in the art, or different field of search required to support the Examiner's *prima facie* burden. Therefore, Applicant respectfully submits that the Restriction Requirement has failed to establish any serious burden of searching and examining all of Groups I-V together. Accordingly, Applicant respectfully requests withdrawal of the restriction requirement and the required election of species and examination of all of claims 1-3, 5, 6, 8-28 and 30-34 together.

CONCLUSION

The kind consideration of the Office is truly appreciated in this matter. If necessary, please charge any petition fee to Deposit Account No. 19-0743.

Respectfully submitted,

MATTHEW S. SOLAR ET AL.

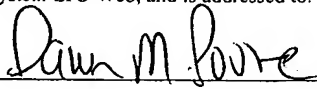
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3rd day of January 2007.

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